REMARKS

Formal Matters

Claims 22-41 are pending.

Claims 22 and 26 are amended. Support for the amendment is found in the last full line of page 4.

Applicants respectfully request reconsideration of the pending claims in view of the remarks made below.

Priority

This application's priority information is set forth in the Applicant Data Sheet (ADS), as filed with the instant application on March 11, 2004.

Pursuant to MPEP § 601.05[1], recitation of priority information in an ADS is all that is necessary to assert priority. Accordingly, a priority claim has already been made.

Oath/Declaration

Pursuant to 37 § CFR 1.63, there is no requirement for a priority claim to be recited in the oath/declaration.

In view of the foregoing, this objection may be withdrawn.

Specification

The specification is objected to because certain documents have been assertedly improperly incorporated by reference. Specifically, the Office asserts that the incorporation by reference set forth on page 14, last paragraph, is improper because it does not identify with any detail the subject matter that is incorporated. The Applicants respectfully traverse this rejection.

The Office cites case law to support its position. However, the Applicants respectfully submit that the question addressed in each of the cited cases was whether a patent application had actually attempted to make *any* incorporation by reference, rather than whether a patent

[1] MPEP § 601.05: "(5) *Domestic priority information.* This information includes the application number, the filing date, the status (including patent number if available), and relationship of each application for which a benefit is claimed under 35 U.S.C. §§ 119(e), 120, 121, or 365(c). Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. §§119(e) or 120, and § 1.78(a)(2) or § 1.78(a)(4), and need not otherwise be made part of the specification."

application identify with any specific detail the subject matter that is incorporated.[2] Accordingly, the cited cases are not relevant to present issue.

In view of the foregoing discussion, the Applicants respectfully submit that the incorporations by reference in question meet the requirements of MPEP § 608.01(p).

Accordingly, this objection may be withdrawn.

The Office also objects to the specification because it does not contain a claim for priority as an initial statement.

Under the new Rules reflecting the changes made by the AIPA and pursuant to MPEP § 601.05, there is no requirement for a priority claim to be recited in the specification if that priority claim is set forth in the ADS. Since this application's priority information is set forth in the ADS filed on March 11, 2004, the priority claim does not need to be made in the specification.

A copy of the ADS is attached for Examiner's convenience.

In view of the foregoing, this objection may be withdrawn.

Rejection under 35 U.S.C. § 102

Claims 22-29, 31, 33-37, 39 and 41 are rejected under 35 U.S.C. § 102(b) as being anticipated by Meade (USPN 5,952,172). Specifically, the Office asserts that Mead discloses a hybridization method that anticipates the claimed method. The Applicants respectfully traverse the rejection.

The basis of the invention is that metal ions can be used to "dope" a transition metal ligand-labeled nucleic acid duplex to make the complex conductive and capable of producing a detectable signal. In accordance with this, each of the rejected claims explicitly recites this "doping" step as a distinct element. For example, claim 1 recites "contacting a metal ion to an initial complex comprising a target and a probe labeled with a transition metal ligand complex", claim 26 recites "contacting said composition [i.e., a composition comprising a target and a probe labeled with a transition metal ligand complex] with a metal ion" and claim 34 recites "contacting said first complex [i.e., a complex containing a target and probe labeled with a transition metal ligand complex] with a metal ion".

[2] For example, in *In re Seversky* (the case cited in *Advanced Display*) the Appellant attempted to incorporate by reference teachings of interest into an application from a grandparent application. However, the application in question was totally devoid of "incorporation-by-

All pending claims therefore recite a "doping" step in which a metal ion is contacted with a probe/target complex labeled with a transition metal ligand complex.

Meade's disclosure relates to methods of labeling nucleic acids with electron transfer agents such as transition metal ligand complexes. Meade discusses using nucleic acids labeled with an electron transfer agent to generate a light signal. However, Meade fails to disclose, teach or fairly suggest any method that employs a "doping" step in which a metal ion is contacted with a probe/target complex labeled with a transition metal ligand complex.

In other words, Meade's metal-containing compounds are not contacted with a probe/target complex labeled with a transition metal ligand complex.

Accordingly, Meade cannot teach all elements of the claims, and this rejection may be withdrawn.

If this rejection is to maintained, the Applicants respectfully request that the Office states where in Meade's disclosure this step is taught. If this cannot be done, the Office is respectfully requested to withdraw this rejection and allow the claims.

Further, the Applicants also wish to point out that the claims not only require a "doping" step, as described above, but also that the metal ion added in the doping step *forms a complex with the target and probe* labeled with a transition metal ligand complex.

This feature is explicitly set forth in claim 22 (i.e., "adding a metal ion to an initial complex.....*to produce an electrically conductive complex*") and claim 34 (i.e., "contacting said furthest complex *to produce an electrically conductive second complex*").

In no way does Meade disclose any method in which a metal ion is doped *to form a complex* with a target and probe labeled with a transition metal ligand complex.

Again, if this rejection is to maintained, the Applicants respectfully request that the Office states where in Meade's disclosure this step is taught. If this cannot be done, the Office is respectfully requested to withdraw this rejection and allow the claims.

In other words, the "doping" step in which a metal ion is added to a complex renders the complex detectable. No such system is disclosed in Meade.

In order to establish this rejection, the Office has attempted to interpret the term "metal ion" to encompass any compound containing a metal atom, and has asserted that because Meade

reference" language - a situation wholly different from the instant application.

discloses compounds that contain metal atoms (col. 9, lines 45-54), the claimed methods must have been disclosed by Meade.

However, even if Meade's disclosure could be interpreted in this way, Meade still fails to teach at least two elements of the claims. The Applicants respectfully submit that Meade falls well short of being an anticipatory reference.

The Applicants respectfully submit that this rejection has been adequately addressed by the foregoing discussion. Withdrawal of this rejection is respectfully requested.

Rejection under 35 U.S.C. § 103

Claims 31, 33, 39 and 41 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Meade in view of Barany (6,027,889). Specifically, the Office asserts that Meade's hybridization methods, in combination with Barany's addressable arrays, render the claims obvious. The Applicants respectfully traverse this rejection.

As discussed above, Meade's disclosure is deficient in that it fails to teach at least two elements of the rejected claims.

Barany's disclosure fails to meet Meade's deficiencies.

As such, Mead and Barany, taken alone or in combination, fail to teach or suggest at least two elements of the rejected claims.

Accordingly, Meade's hybridization methods in combination with Barany's addressable arrays, cannot render the claims obvious, and this rejection may be withdrawn.

CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078.

Respectfully submitted,
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Date: 12/16/04

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